

Remarks

The examiner has rejected claims 1, 2, 5, 6, 9, 10, 11, 12, 15, 16, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application Publication Number 0 686 920 to Jeong et al (hereinafter Jeong et al) in view of the Microsoft Press Computer Dictionary, Third Edition (hereinafter Microsoft). This rejection is not thought to be well taken, especially in view of the amendments to claims 1 and 11, and upon which all of the other claims depend, either directly or indirectly.

With respect to claim 1, this claim as been amended to positively claim phase rotation by a phase rotator, in conjunction with edge detecting to convert the analog signal to a digital signal. There is nothing in the prior art cited to suggest this and, thus, claim 1 is clearly allowable. (This does not constitute new matter since it is described on page 6, line 17 through page 7, line 5, and shown in Figure 3.) Essentially, the same limitation has been added to claim 11, which is the structural counterpart of method claim 1, and, thus, claim 11 is also believed to be allowable. Claims 2, 5, 6, 9 and 10 are dependent upon claim 1 and claims 12, 15, 16, 19 and 20 are dependent upon 11 and, for the same reasons, are believed to be allowable.

The examiner has rejected claims 3, 4, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Jeong et al and Microsoft in view of U.S. Patent 6,222,380 to Gerowitz et al (hereinafter Gerowitz et al). This rejection is not thought to be well taken, especially in view of the fact that these claims are dependent upon claims 1 and 11, both of which are believed to be allowable for the reasons pointed out above. Moreover, it is not believed that Gerowitz et al teach or suggest the structure claimed in claims 3 and 13, or claims 4 and 14, which are, respectively, dependent thereon. As shown and described in Gerowitz et al, the

data is first read into a group of four latches, and read from these latches through a mux to a single latch which operates at four times the speed of the system clock. On the other hand, applicants are claiming the embodiment shown in application Figure 3 wherein the data is read from a register two bits at a time to first and second single bit registers, and then to a subsequent one bit register until all the bits from the first register have been read. This is clearly not taught nor suggested by Gerowitz et al.

It is not enough that one may modify a reference in view of a second reference, but rather it is required that the second reference suggest modification of the first reference and not merely provide the capability of modifying the first reference.

The CAFC stated In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

“The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the “burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103”. Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).”

The law is quite clear that, in order for a claimed invention to be rejected on obviousness, the prior art must suggest the modifications sought to be patented; In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic's case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification

obvious unless the prior reference suggests the desirability of the modification. The CAFC in the case of In re Gorman, 18 U.S.P.Q. 2d (CAFC 1991) held at page 1888:

"When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant [citation]. 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination [citations]. . . .

The references themselves must provide some teaching whereby the applicant's combination would have been obvious."

Further, the CAFC, in In re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992) held:

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Most significantly, the CAFC in the recent case of In re Dembiczak, 50 U.S.P.Q.2nd 1614 (CAFC 1999) held at 1617:

...(examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]');

Thus, it is clear that where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference through some objective teaching and cannot come from the application itself, which is not the case here.

Reconsideration and allowance of the claims in the application is respectfully requested.

Respectfully submitted,

Date

7/15/04

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